REMARKS

In response to paper No. 11, the Examiner's provides further explanation for maintaining the restriction requirement in Paper No. 12. Paper No. 12 was mailed 16 April 2003 after the filing of the Amendment of 11 April 2003. According to MPEP 714.05, the Examiner should immediately inspect an Applicant's amendment when it is received, and if it is filed before the mailing date of a regular action, a supplemental action by the Examiner should be mailed. According to MPEP 714.03(a), when entry of a subsequent Amendment is disapproved, the Examiner should immediately notify the applicant using form paragraph 7.47.

In view of Paper No. 16, mailed 8 May 2003 it is assumed that the Examiner has entered the 4/11/03 Amendment amending the specification and claims 20-25 and 33, as no communication indicating otherwise has been received.

Applicant respectfully requests full consideration of the properly filed Amendment filed 11 April 2003 along with consideration of this Amendment. The present Amendment has canceled claims 1-19 and 34-69 and substituted claims 70-135 therefor.

Regarding Paper No. 12, Applicant considers the Examiner's explanations for maintaining the restriction to merely be an indication of the difference in "scope" of the claims and not an explanation of separate "utility."

Claim 1 of Group I, claim 20 of Group II, claim 34 of Group III have utility of data protection by *digital content encryption*.

The Examiner has not provided any suggestion of utility other than data protection. Instead,

on page 3 of Paper No. 16, lines 6-8, the Examiner agrees that Groups I and II share the same of utility of data protection by digital content encryption.

The Examiner's further argument of separate utility on page 2 of Paper No. 12, last paragraph and page 3 of Paper No. 16, first paragraph is untenable because whether or not the use of a server or a terminal unit are claimed is a difference in the scope of the invention claimed as a first part of showing two-way distinction set forth in MPEP 806.05(c). As for the second part of showing two-way distinction, it must be shown that the subcombination has utility by itself or in other and different relations. However, the Examiner has not applied MPEP 806.05(c), but instead has applied MPEP 806.05(d).

Accordingly, only the Examiner's argument that "[Group II] is available for use in systems where neither the content nor the key need be transported from server to user . . .could read on a prerecorded DVD" as compared to the statement that "Group I reads on a connected client/server arrangement or on-line connection" appear to be an attempt reflect an argument based on "utility," however, the argument only reflects the Examiner opinion of what type of system my employ the two Groups, not the "utility" of the invention being claimed.

Also, note that regarding the client/server argument, as is well known in the art:

1) In general, a server is a computer program that provides services to other computer programs in the same or other computers;

2) The computer that a server program runs in is also frequently referred to as a server (though it may contain a number of server and client programs); and

3) In a client/server programming model, a server is a program that awaits and fulfills

requests from client programs in the same or other computers. A given application in a computer may function as a client with requests for services from other programs and also as a server of requests from other programs.

Regarding the argument indicating what type of system may employ the invention of Group II, there has been no showing that the invention could not be employed in the same type of system employing the invention of Group I. As evidence that the invention of Group II could be used in a client/server type of system, see the amendment to claim 20 filed 4/11/03.

Now, as set out in 35 U.S.C. 101, and invention must have utility to be patentable, and the inventions of Group I and Group II both have the same utility of **data protection through encryption/decryption**. That is, the use of the claimed invention(s) is for data protection through encryption/decryption, and the type of system, whether it be a DVD player or a computer, etc., employing the claimed invention has no bearing on the claimed utility of the invention.

Additionally, since the data protection is due to the **encryption** of the digital contents, and both Group I and Group II perform such encryption, and both transmit the encrypted data in a header of a copyright protection protocol, Groups I and II are both classifiable in class 713 subclass 160.

Note that the Examiner indicated that Group I, covered by claims 1-19 and 37-44 drawn to an apparatus and method of copy protection by storing key information was classified in Class 713, subclass 193. However, class 713, subclass 193 is subject to matter wherein unauthorized access to information held in static memory elements is prevented under subclass 189 (Subject matter wherein cryptography is used in the protection of the operation of a computer). None of the limitations set forth in claims 1-19 and 37-44 (now claims 70-94) define an invention used to protect

the operation of a computer, especially by preventing unauthorized access to information held in a static memory.

The Examiner has indicated that Group III covered by claims 34-35 and 52-53 is drawn to an apparatus and method of user access supposedly classified in class 713 subclass 182. Since subclass 182 is drawn to subject matter wherein **authorization to** a digital processing system is dependent upon cryptographically processed data for personal verification, and claim 33 (now claim 89) is drawn to a method for encrypting digital content using a temporary validation key in response to a request signal from a user, and transmitting the encrypted digital content. It is clear that Group III is not classifiable in class 713 subclass 182 because no limitation is directed towards **authorization to** a digital processing system.

The Examiner has indicated that Group IV covered by claim 36 drawn to a method of authenticating through registration authority classified in class 713 subclass 155, subject matter wherein a single source confirms the legitimacy of a computer on the network or provides logon authorization. Claim 36 has no limitation regarding confirmation of a computer on a network nor limitation regarding providing logon authorization.

The Examiner has indicated that Group V covered by claims 45-61 and 66-69 are drawn to a method of cryptography using code signal and classifiable in class 380 subclass 239, however this subclass is indented under 380/210: Video electric signal modification (e.g., scrambling): Subject

matter wherein a video electric signal is made unintelligible by varying at least one of its parameters. Subclass 239 further modifies subclass 210 by requiring subject matter wherein a control coding signal modifying the video electric signal has itself been made unintelligible. No claim of Group V calls for the scrambling of a video electric signal nor utilizes a control coding signal to modify a video electric signal.

In Paper No. 12 the Examiner argues that the claims may be read in light of the disclosure which discloses digital TV.

The courts (e.g., Federal Circuit) have consistently held that limitations appearing in the specification will not be read into the claims. See *Intervet America, Inc. v. Kee-Vet Laboratories, Inc.* 887 F.2d 1050, 12 USPQ2d 1474 (Fed. Cir. 1989). *Rolls-Royce Ltd. v GTE Valeron Corp.*, 800 F.2d 1101, 231 USPQ 47 (Fed. Cir. 1986) (reference in the specification to an object does not constitute in itself a limitation in the claim). See also MPEP 904.01.

Also, looking to the disclosure further, the specification states digital information that is requested by the user is sometimes referred to in this specification as digital content. Briefly, the digital information is some sort of data such as music or a literary composition, that has been converted into digital signals that are stored in the form of a single file. The user may select the digital information that has been stored in the form of a file through the network, and then access and read or listen to the digital information by using a personal or laptop computer with the aid of an application program for network communication and a device such as compact disk drive or a DVD that is either incorporated into the computer or is connected as a peripheral accessory to the computer, for replaying the digital information. The digital information includes all of the

information that has been converted into the digital data by the information provider and stored in the form of file, such as a magazine, a book, a dictionary and a drawing or illustration, as well as a song.

Accordingly, the Examiner has improperly taken one example of digital information or digital content out of many different examples to limit claim 36 to "video". Similarly, the Examiner has indicated that Group VI covered by claims 54- 56 drawn to a method of key distribution are classified in class 380 subclass 278, and Group VII covered by claims 57-65 drawn to a method of copy prevention and protection are classified in class 380 subclass 201.

In all the examples of digital information or digital content, the information is encrypted and transmitted over a computer network which fits under class 713, subclass 150, subject matter for cryptographically protecting the transfer of data among a plurality of spatially distributed (i.e., situated at different locations) computers or digital data processing systems via one or more communications media (e.g., computer networks) wherein the computers or digital data processing systems employ the data in data processing before or after the transferring, and wherein the transferring affects the data transfer between the computers, or an indented subclass under subclass 150.

Further, as stipulated in MPEP §803, if the search can be made without serious burden, the examiner must examine it on the merits. The examiner has not alleged any serious burden, but instead refers to their "separate classification."

It has been shown above that the "separate classification" is due to Examiner error is

suggesting that one or more Groups have claims directed to video. Since there is no video being claimed in any of the Groups, then classification for all Groups is in Class 713.

Thus there appears to be no burden on the Examiner in searching of Groups III and IV because the claims are classified in class 713 and contain subject matter found in the elected claims, therefore the examiner must examine the entire application as stipulated in MPEP §803. That is, Groups I-VII all have utility in copyright protection according to a digital content encryption apparatus or method classifiable in class 713.

New claims 70-94 belong to the elected Group II, class 713 subclass 160, **Packet header designating cryptographically protected data**: subject matter for cryptographically protecting the transfer of data among a plurality of spatially distributed (i.e., situated at different locations) computers or digital data processing systems via one or more communications media (e.g., computer networks) wherein the computers or digital data processing systems employ the data in data processing before or after the transferring, and wherein the transferring affects the data transfer between the computers, and wherein the data transfer uses an integral unit (header) including information indicating that the associated data is encrypted or signed.

The examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

Should a Petition for extension of time be required with the filing of this Amendment, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

Certified English language translations of Korean Patent Application Serial No. 98/39808 filed on 24 September 1998 and Korean Patent Application Serial No. 98/39809 filed on 24 September 2003 accompany this response.

No fee is incurred by this response.

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